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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/738,332	12/17/2003	Carolus Matthias Anna Maria Mesters	TS1313 (US)	7939
Yukiko Iwata Shell Oil Company Legal - Intellectual Property P.O. Box 2463 Houston, TX 77252-2463				
7590 11/10/2009			EXAMINER BOYER, RANDY	
			ART UNIT 1797	PAPER NUMBER
			MAIL DATE 11/10/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/738,332

**Applicant(s)**

MESTERS ET AL.

**Examiner**

RANDY BOYER

**Art Unit**

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 9, 11-21, 24-26, 30 and 33-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 9, 11-21, 24-26, 30 and 33-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 21 October 2009 has been entered.

### ***Response to Amendment***

2. Examiner acknowledges Applicant's response filed 21 October 2009 containing amendments to the claims.
3. Claims 1, 2, 9, 11-21, 24-26, 30, and 33-44 are pending.
4. The previous rejections of claims 25, 26, 30, and 33-44 under 35 U.S.C. 103(a) are withdrawn in view of Applicant's amendment to the claims.
5. The previous rejections of claims 1, 2, 9, 11-21, and 24 under 35 U.S.C. 103(a) are maintained.

6. New grounds for rejection of claims 1, 2, 9, 11-21, 24-26, 30, and 33-44 under 35 U.S.C. 103(a) are entered. The rejections follow.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1, 2, 9, 11-21, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frame (US 3,978,137) in view of Yoo (US 3,945,914) and Mahadev (WO 92/20621).

11. With respect to claims 1, 2, 9, 11-19, 21, and 24, Frame discloses a process comprising contacting a hydrocarbon feedstock containing mercaptan compounds with air and a catalyst comprising platinum, rhodium, or iridium on a zirconia support at a temperature between about 50C and about 400C at a pressure of about 1 atm (see Frame, column 1, lines 4-12; column 2, lines 42-45; column 3, lines 1-19; and column 4, lines 10-13 and 60-65).

Frame does not explicitly disclose wherein the feed is a gaseous feedstock containing at most 5 vol% hydrogen sulfide and where the feed mixed with the oxygen-containing gas has an oxygen-carbon ratio below 0.10. Frame also does not explicitly disclose wherein the platinum, rhodium, or iridium are present at a concentration in the range from 0.02% to 10% based on the weight of the catalyst.

However, Mahadev discloses a feed stream of natural gas containing up to 10 wt% hydrogen sulfide (see Mahadev, page 1, lines 21-24; and page 2, lines 3-9). Mahadev explains that the adsorptive capacity of the catalyst remains unchanged for feeds with less than 10 wt% of hydrogen sulfide (see Mahadev, page 32, lines 3-9). In addition, Yoo explains that a hydrocarbon feed mixture of oxygen-containing has an oxygen-sulfur ration of about 0.5 with the sulfur content of the feed being about 1 wt%.

Because hydrocarbons comprise carbon atoms, 99% of the feed would contain carbon atoms. Thus, the oxygen-carbon ratio of the feed would be approximately 0.005 (see Yoo, column 1, lines 64-68; and column 2, lines 46-63). Yoo further explains that the concentration of oxidant is usually dependent on the amount of sulfur present in the hydrocarbon material (see Yoo, column 2, lines 46-53).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the process of Frame to include a feed stream of natural gas containing up to 10 wt% hydrogen sulfide (as taught by Mahadev) in order to preserve the adsorptive capacity of the catalyst. Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the process of Frame to provide an oxygen-carbon ration of the feed of approximately 0.005 since the amount of oxygen present in the feed is dependent upon the amount of sulfur present in the feed (as evidenced by Yoo).

With respect to the claimed concentration of metals present in the catalyst, Examiner notes that differences in concentration will generally not support the patentability of subject matter encompassed by the prior art unless there is evidence to establish that such concentration is critical. See MPEP § 2144.05(II)(A).

Finally, with respect to Applicant's amendment of the transitional phrase "comprises" to "consisting essentially of" to introduce the catalyst composition to be used in the claimed process, Examiner notes that "for the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication of what the

basic and novel characteristics [of the claimed invention] actually are, 'consisting essentially of' will be construed as equivalent to 'comprising.'" See MPEP § 2111.03.

12. With respect to claim 20, Mahadev discloses a flue gas having a concentration of sulfur dioxide in the range of 1000 ppm to 2000 ppm (see Mahadev, page 17, lines 7-9).

13. Claims 1, 2, 9, 11-21, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Jong (US 5,720,901).

14. With respect to claims 1, 2, 9, 11-21, and 24, De Jong discloses a process comprising: contacting a mixture of a hydrocarbonaceous feedstock (see De Jong, column 4, lines 20-24) containing any of various sulfur compounds (see De Jong, column 4, lines 65-67; and column 5, lines 1-16) in an amount ranging from 0.05 ppm to 100 ppm (see De Jong, column 5, lines 22-26) and an oxygen-containing gas (see De Jong, column 4, lines 30-31) with a catalyst (see De Jong, column 4, lines 65-67), wherein the catalyst may comprise platinum, rhodium, or iridium in the range of 0.01 wt% to 20 wt% (see De Jong, column 6, lines 6-10), supported on a catalyst carrier (e.g., zirconia) (see De Jong, column 6, lines 11-14).

De Jong does not explicitly disclose wherein the contact temperature is at most 500°C or wherein the feed mixture has an oxygen-to-carbon ratio of below 0.15.

However, De Jong discloses wherein the process may be operated at any suitable temperature (see De Jong, column 5, line 44; and claim 14) and any suitable pressure (see De Jong, column 5, lines 36-37; and claim 14), and wherein the feed may comprise the hydrocarbon feedstock and oxygen in any amount sufficient to give a suitable oxygen-to-carbon ratio (see De Jong, column 4, lines 50-52). Moreover, De

Jong explains that: (1) the level of sulfur compounds in the feed is variable (see De Jong, column 5, lines 22-26); and (2) the desired level of conversion will necessarily depend upon the severity of the process conditions (temperature, pressure) used (see De Jong, column 5, lines 36-49).

Therefore, Examiner finds Applicant's limitations regarding process temperature and oxygen-to-carbon ration to be of no patentable consequence because: (1) such conditions are not critical to the process of De Jong, i.e. the process of De Jong could conceivably be carried out at any temperature and with any oxygen-to-carbon ratio so long as De Jong's overall objectives were satisfied; and (2) De Jong recognizes process temperature (along with pressure) as a result-effective variable, changes in which will necessarily result in changes to the overall level of conversion of the feedstock components. See MPEP § 2144.05(II)(A),(B).

15. Claims 25, 26, 30, and 33-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Jong (US 5,720,901) in view of D'Souza (US 4,233,276).

16. With respect to claims 25, 26, 30, and 33-44, see discussion *supra* at paragraph 14.

De Jong discloses wherein the effluent from the oxidation step may be further treated by passing such product stream through a bed of adsorbent suitable for removing the sulfur-containing components produced in the oxidation step (see De Jong, column 8, lines 11-27).

De Jong does not explicitly disclose wherein the adsorbent is copper oxide or barium oxide.



However, De Jong discloses wherein the adsorbent may be zinc oxide (see De Jong, column 8, line 27) which is an art-recognized substitute for copper oxide and barium oxide as an adsorbent material for the removal of sulfur-containing components in an oxidized stream (see D'Souza, column 6, lines 13-25). In this regard, Examiner notes that the mere substitution of prior art elements known to be useful for the same purpose supports a finding of *prima facie* obviousness. See MPEP § 2144.06.

### **Conclusion**

17. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure: Dupin (US 4,937,058) and Voirin (US 4,399,112).

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randy Boyer whose telephone number is (571) 272-7113. The examiner can normally be reached Monday through Friday from 10:00 A.M. to 7:00 P.M. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn A. Caldarola, can be reached at (571) 272-1444. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Randy Boyer

Examiner, Art Unit 1797

/Glenn A Caldarola/

Acting SPE of Art Unit 1797